

## Remarks

### **1. Summary of the Office Action**

In the office action mailed July 11, 2007, the Examiner rejected claim 18 under 35 U.S.C. § 112 on grounds of indefiniteness, the Examiner rejected claims 1, 4, 7-17, 19-23, and 25 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,87,987 (Vacanti), and the Examiner rejected claims 2-3, 5-6, 18, and 24 under 35 U.S.C. § 103(a) as being allegedly obvious over Vacanti in view of U.S. Patent No. 6,035,281 (Crosskey).

### **2. Status of the Claims**

Applicant has corrected a minor typographical error in claim 18. The other claims remain in their original form.

Pending are claims 1-25, of which claims 1, 4, 7, 10, 13, 16, and 20 are independent and the remainder are dependent.

### **3. Response to Claim Rejections**

#### **a. Response to § 112 Rejection**

The Examiner rejected claim 18 on grounds that it included the language "the other web content." The Examiner asserted that that language rendered the claim indefinite "because it is unclear whether the limitation(s) following the phrase are part of the claimed invention." (*See* office action, at page 2, lines 11-13).

Applicant notes that there were no limitations following the phrase "the other web content," so Applicant assumes the Examiner's assertion in that regard was a typographical error. Applicant has amended the claim, however, to remove the word "other," which was included inadvertently. Presumably, this change overcomes the problem perceived by the Examiner.

**b. Response to § 102 Rejections over Vacanti**

The Examiner has rejected each of the independent claims as being allegedly anticipated by Vacanti. Applicant submits that this rejection is clearly improper and should be withdrawn, because Vacanti does not expressly or inherently teach the combination of elements set forth in any of the independent claims as would be required to properly establish anticipation under M.P.E.P. § 2131.

At a minimum, Vacanti does not teach the claim element of *computing a size-based cost to access web content*, recited by the independent claims to be carried out (i) during transmission of the web content in the communication path (claims 1, 4, 13, and 16), (ii) at an intermediation system in the web communication path (claims 7, 10, and 20).

In rejecting independent claims 1 and 4, the Examiner asserted that Vacanti teaches this element in Figure 15, where Vacanti shows a table indicating the cost of various web content. The Examiner reasoned that "the price of the articles or web contents inherently means the cost have been computed based on the content size." (*See, e.g.*, office action, at page 3, line 10-11). With all due respect, this is not the case.

The fact that Vacanti teaches a table showing the cost of various web content does not in any way mean that the cost is necessarily computed based on the size of the web content. It is well known in the art that some web content providers charge various different costs for granting access to their web content, and the costs do not necessarily have anything at all to do with the size of the web content but may, for instance, relate to the value of the web content or to other factors.

M.P.E.P. § 2112 permits an Examiner to conclude that a claim element is "inherently" met by disclosure in a prior art reference only if the claim element necessarily follows from the

teachings of the disclosure. In this case, the Examiner has clearly not met that burden. The Examiner has asserted that Vacanti's depicting of a table showing prices of various web content inherently means that those costs were computed based on content-size. However, it is certainly possible that the prices shown by Vacanti are set on some other basis completely unrelated to size of the content, or that the prices are set arbitrarily. Vacanti does not mention how or why different prices are set for different web content. Therefore, the present claim element of computing a size-based cost to access web content does not necessarily follow from Figure 15 of Vacanti or from other teachings of Vacanti.

Furthermore, in rejecting the other independent claims (7, 10, 13, 16, and 20), the Examiner additionally erred by asserting that Vacanti teaches "computing a size-based cost to access the web content" or "determining a cost of the referenced web content based at least in part on a size of the referenced web content" at column 22, lines 4-7. Vacanti includes no such teaching.

At column 22, lines 4-7, Vacanti states: "Handler logic modules 80 might then include an ADDCOST( ) function, which is executable by processor 68 to add the indicated cost into the referenced hyperlink." Yet this statement does not teach, either expressly or inherently, that cost would be determined based on the size of the referenced web content.

Because Vacanti does not teach the combination of elements set forth in any of the present independent claims, Vacanti does not anticipate the independent claims. Therefore, Applicant submits that the independent claims are allowable. Furthermore, without conceding the Examiner's other assertions, Applicant submits that all of the dependent claims are allowable for at least the reason that they depend from the allowable independent claims.

**c. Response to § 103 Rejections over Vacanti in view of Crosskey**

As further noted above, the Examiner rejected claims 2-3, 5-6, 18, and 24 under 35 U.S.C. § 103(a) as being allegedly obvious over Vacanti in view of Crosskey.

For the above reasons, Applicant submits that these claims are allowable.

Furthermore, the subject matter disclosed by Vacanti, to the extent relevant, was owned or subject to an obligation of assignment to the same person as the subject invention recited by claims 2-3, 5-6, 18, and 24 at the time the invention was made. Therefore, under 35 U.S.C. § 103(c), Vacanti is disqualified as prior art.

As the primary Vacanti reference is disqualified as prior art for purposes of the § 103(a) rejection, the Examiner has not made out the requisite *prima facie* case of obviousness of claims 2-3, 5-6, 18, and 24. Therefore, for this additional reason, Applicant submits that claims 2-3, 5-6, 18, and 24 are allowable.

**4. Conclusion**

For the foregoing reasons, Applicant submits that all of the pending claims are in condition for allowance, and Applicant thus respectfully requests favorable reconsideration.

Should the Examiner wish to discuss this case with the undersigned, the Examiner is welcome to call the undersigned at (312) 913-2141.

Respectfully submitted,

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